

REMARKS

After entry of the foregoing amendment, claims 1-22 remain pending in the application.

Drawings have been submitted, in accordance with the Examiner's requirement. No new matter has been introduced.

Concerning the alleged introduction of new subject matter into the specification (*i.e.*, priority application 09/571,422), reconsideration is requested.

The Examiner states "the specification does not refer to any application to be considered as incorporated by reference" (Action, paragraph 3).

The Examiner's statement is incorrect. At page 7, lines 23-26, applicants stated:

*To provide a comprehensive disclosure without unduly lengthening this specification, the above-cited patent applications are incorporated herein by reference.*

Thus, contrary to the Examiner's statement, application 09/571,422 – together with the other patent applications referenced in the specification, *have been expressly incorporated by reference.*

The alleged introduction of new matter (Action, paragraph 4) is also incorrect in view of the subject matter of incorporated application 09/571,422.

The objection to the specification expressed in paragraph 5 should also be reconsidered in view of the Examiner's error.

Likewise, reconsideration of the rejection of claims 4-7 and 11-19 under § 112, ¶ 1, is also requested in view of the proper incorporation-by-reference of application 09/571,422.

(The assembly of speech from component phonemes is notoriously old in the speech synthesis art. Since a patent specification "need not teach, *and preferably omits*, what is well known in the art,"<sup>1</sup> omission of such information is sanctioned, and indeed encouraged by Office policy.)

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<sup>1</sup> *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). See also MPEP § 2164.05(a).

The rejections of claims 15-19 under § 112, ¶ 2, also seem predicated on an enablement issue that arises because the Examiner failed to consider incorporated-by-reference application 09/571,422. The '422 specification answers questions such as "How does one sense a gesture?"

The rejection of claim 2 as anticipated by Rhoads 6,311,214 is respectfully traversed.

Among other elements, claim 2 requires "*sensing a page or cover of a children's book.*"

The Action cited Rhoads at col. 4, lines 35-39 for this limitation. However, this excerpt does not teach the quoted limitation. The excerpt reads:

*Optics*

*For any system to decode steganographically encoded data from an object, the image of the object must be adequately focused on the digital camera's CCD (or other) sensor.*

No teaching of "a page or cover of a children's book" is provided.

Claim 1 is rejected as obvious over Okamoto (6,285,924) in view of Price (4,675,519) and Rhoads '214. The rejection is traversed.

Okamoto is understood to disclose a vehicle accessory in the form of a figure with head and body, which can respond to spoken commands to assist with vehicle operation (e.g., vehicle navigation).

The 50+ page specification has a single reference to a CCD, found at col. 16, line 60. The surrounding text states:

*Here, as a voice of "Take a picture please" is inputted and it is interpreted through a voice recognition that a photography request is raised, a voice of, for example, "Hei! pose" is generated, and a CCD camera, which is incorporated into the doll, is automatically operated to perform a photography and/or a recording.*

*This feature makes it possible to perform a photography on a hands-free basis, even if a car is in motion.*

It will be recognized that Okamoto's CCD is employed solely for data capture.

The image data captured by Okamoto's CCD is not described as being processed in any way, and is not used to trigger any action.

Price discloses a doll that senses light using phototransistors, and responds with spoken phrases. Price's doll does not include a CCD, and does not involve any image processing.

Rhoads '214 is one of the present assignee's prior patents, and concerns digital watermarking/steganography.

The Action proposes selectively picking different elements from Okamoto, Price, and Rhoads, and jig-sawing them together to yield the arrangement of claim 1 (and in the process, selectively ignoring many other teachings of these references). This is an example of hindsight reconstruction, not obviousness.

The only rationale offered in the Action to justify the proposed combination is as follows:

*Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Okamoto to include a doll having two eyes and a sensing element positioned to view out of at least one eye as taught by Price and to further include a steganographic watermark detector for sensing watermark data on an object and triggering an action in response as taught by Rhoads to provide a system by which users can interact with computer-based devices.*

The first part of this statement simply details the elements selected by the Examiner to meet different limitations of applicants' claim 1. The only "rationale" offered in support of the proposed combination is the underlined phrase at the end. But it will be recognized that this clause states an ambition so broad as to be met by myriad combinations of references. Nothing in this statement explains why an artisan would have been led to the particular arrangement defined by claim 1.

In sum, the Action has failed to establish a *prima facie* case of obviousness.

Since the Office has failed to meet its initial burden under the statute, applicants do not belabor this response with further remarks concerning the art, or concerning the patentability of the claim.

Claims 2 and 9 stand rejected as obvious over Reber '261 in view of Rhoads '436.

No "Reber '261" art seems to have been identified in this application.

Clarification is requested.

Moreover, from the statements in the Action, it appears neither of the references teaches sensing a page or cover of a children's book, as required by the claim. Thus, even if the teachings of the art were hybridized as indicated by the Examiner, this element would still be missing, and the claimed arrangement would not result.

Again, since a *prima facie* showing has not been established, other points that might be made concerning the claim and the rejection are reserved.

The rejection of claims 3-20 dependent from claim 2 likewise fails, and these claims are likewise not here belabored given the lack of a *prima facie* showing.

(As noted in connection with claim 1, the required explanation of rationale justifying the selective incorporation of certain teachings from the art, the selective ignoring of other teachings, and the particular modification/combination of elements so as to yield the claimed combinations, is inadequate for each of the other claims rejected under § 103. However, given other grounds on which a *prima facie* showing has not been established, these further points are not here detailed.)

(As a point of practice, the undersigned is aware of no Board decision that has ever affirmed an obviousness rejection based on four or five different prior art references, as proposed by the Examiner in connection with claims 4, 5, 6, 7, 8, 11, 12, 13, 14, 15, 16, 17, 18, 19, and 20.)

To advance prosecution of this case, an interview with Examiner Rada and Acting Supervisory Primary Examiner Harrison is requested prior to issuance of any further Action. The undersigned will call Examiner Rada about September 30 to schedule such an interview.

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Respectfully submitted,

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